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| 09/769,147      | 01/25/2001  | Spencer A. Rathus    | 660-029             | 8430             |

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Ward & Olivo  
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EXAMINER

LE, THIEN MINH

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,147

Applicant(s)

RATHUS ET AL.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 168-284 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 168-284 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The preliminary amendment filed on 1/25/2001 has been entered. Claims 168-284 are presented for examination.

#### ***Obvious Type Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 168, drawn to the apparatus and method claims 279 and 282, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because a magazine is merely a particular type of printed as recited in claim 1 of the patent. In this case, replacing a printed matter with a a magazine is merely a substitution of an art recognized equivalent; and thus would have been obvious (see MPEP 2144.06 - Art Recognized Equivalence for the Same Purpose).

Claims 168-278, drawn to the apparatus and method claims 280-281 and 283-284, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-300 of Copending Application No. 09/769,136; claims 168-271 of Copending Application No. 09/769,138; claims 168-262 of copending Application No. 09/769,137; claims 168-267 of copending Application No. 09/769,141; claims 168-292 of copending Application No. 09/769,143; claims 168-267 of copending Application No. 09/769,144; claims 168-298 of copending Application No. 09/769,146. This is a provisional obviousness-type double patenting rejection.

Claims 168-284 are rejected as being obvious over the claims of the aforementioned copending Applications. Though the languages of the claims are not identical, they would have been obvious in view of each other. It is respectfully submitted that business cards, magazines, educational printed media, etc., are merely the intended applications of the underlying inventiveness concepts of reading and retrieving data set forth in instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 168, drawn to the apparatus and method claims 279 and 288, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (Wellner – 5,640,193) in view of Rhoads (Rhoads – 5,841,978).

Wellner discloses a system that allows multimedia service access by reading marks on an object. Specifically, Wellner discloses a scanner 11 for reading bar codes [see summary of the invention, col. 2]. The scanned data is decoded into a request and communicated to server 13 for handing the decoded request. In col. 4, lines 30-35, Wellner discloses that the bar codes work similar to URL identifiers. Figure 2 of

Wellner shows the use of a bar code reader, a catalog 10, a communication network for retrieving encoded information, and a display system for displaying information to a reader.

According to Wellner, it is contemplated that each photograph or advertisement in a newspaper, magazine, or catalog can be accompanied by a printed bar code or alphanumeric ID. In order to retrieve the associated multimedia document, a user scans the printed ID with the scanner or pen (11), and the movie, product information, or game immediately starts to play. A variety of catalogs can be published (by the service provider or by third parties) catering to individual interests, e.g., old movies, horror films, or multi-user interactive games. Newspaper advertisements, magazines, books and pamphlets can also include these printed marks just as they now use phone numbers. Home shopping retailers can provide specialty catalogs. Distance learning applications can put printed marks into text books.

The claim differs in calling for the use of a ticket rather than other form of printed matters, i.e. catalogs, pamphlets, books, advertisements, magazines, films. However it would have been obvious to incorporate the teaching of Wellner on a printed media such as a ticket. The modification is merely a design consideration which is well within the skill level and expectation of an ordinary skilled in the art. Reference of Rhoads is cited as evidence showing the conventionality of the use of a ticket as a printed media for URL encoded codes. Thus, replacing a printed matter with a particular printed media such as a ticket is merely a substitution of an art recognized

equivalent; and thus would have been obvious (see MPEP 2144.06 - Art Recognized Equivalence for the Same Purpose).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 169-278, drawn to the apparatus and method claims 280-281, and 283-284, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (Wellner – 5,640,193) in view of Rhoads (Rhoads – 5,841,978), and further in view of the general teachings of the prior art of record, in particular, in view of Hidary et al. (hereinafter Hidary – 5,774,664); Shachar – 6,012,102; Veeneman et al. – 5,774,874; Montanari et al. – 5,478,990; Dudle et al. – 5,570,291 ; Brooke (GB 2,109,600) ; Kaoko ( JP Patent No. 404269048A – 9/1992); and Teruo (JP406188962A – 7/1994).

Regarding 169-278, drawn to the apparatus and method claims 280-281, and 283-284, see the discussions above. The claims differ in calling for the use of a data-link associating with the claimed code; the use of the specific type of network such as the Internet, the phone network; the use of the specific type of coding medium, i.e. magnetic, bar-code, watermark; the use of the specific printed media, i.e. telephone directory, electronic service directory; and so on. It would have been obvious to incorporate these limitations in the system as taught by Wellner. The use of a bar code scanning system with each of these claimed features are clearly illustrated by the prior art of record. Without any specific unexpected result, the examiner is of the view that modifying Wellner's system to include these features would have been merely design consideration which would have been obvious in light of the conventionality of these features in the prior art of record. Specifically, it would have been obvious to associate the code in a data-link. The use of a data-link for feeding encoded information is notoriously known and old that an ordinary skilled artisan would have been used the

technique as an alternative input source. Reference to Hidary is cited as evidence showing the conventionality of the claimed limitation.

Specifically, Hidary discloses an enhanced video programming system and method for incorporating and displaying retrieved integrated internet information segments. The system includes a client software 106 retrieves URLs from the video program embodiment of FIG. 1) or directly from the Internet connection (embodiments of FIGS. 2 and 4), interprets these URLs and directs the JAVA enabled browser 98 to retrieve the particular relevant Web pages 102, and synchronizes the retrieved Web pages to the video content for display on the user's computer 16, as shown in FIGS. 3 and 4 and explained in more detail in the specification.

For similar reasons, it would have been obvious to include the use of alternative form of a code such as a watermark, an invisible barcode, a magnetic code, a printer character, a invisible icon; the use of various different type of networks, the use of a menu, listings, the method of payments and shipments. It would have been obvious to incorporate all these limitations in the system as taught by Wellner, as has been modified above by Hidary. The general teachings of the prior art include the use of a watermark, a magnetic code, a printed character, an icon, etc., as a data input source. Without any specific and unexpected result, replacing one source of input with another known source of input would have been design consideration; and would have not been considered novel. For similar reasons, it would have been obvious to replace one type of network with another since the use of various different networks are known to an ordinary skilled artisan in the art. Choosing one type of network over another would

merely depend on the type of applications, the services being offered. Finally, it would have been obvious to include the claimed steps of providing payment, shipping, and returning information in the combined systems. The methods of providing payment/shipping/returning information are notorious known and old and have been made commercially available. Various references in the cited prior art of record are herein discussed as evidence showing the conventionality of some of the claimed limitations.

Shachar discloses a system using machine-readable printed symbols created from encoded data resource specifiers to establish connection to data resource on data communications network. Specifically, Shachar provides a technique for encoded printed presentation and manipulation of addresses of data and/or information resources located on an Internet, e.g., the Internet. The printed form of the addresses can be, for example, a barcode, or other digitally encoded representation which can be scanned electronically. A terminal device for Internet access (e.g., a personal computer or smartphone adapted to data services) is provided with a scanner for reading the encoded address. Application software running on the terminal device would then use the scanned address to establish a network connection, or simply to store the scanned address for later access. Using this technique, it is possible to scan a bar coded representation of a WWW site address (printed, for example, on a business card, in a newspaper ad, or the like) and to automatically and immediately generate an Internet connection to the WWW site and to display/activate a web page.

Veeneman discloses a multi-merchant gift registry system. The system includes a bar code scanner 40 could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes bar codes for the items. The registrant would communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not limited to a physical paper catalog, but also encompasses things such as CD-ROMs, and other data storage devices. In this embodiment, it would be required that there be a unique bar code for each catalog to identify the supplier of the particular item. This identifying code could be on the front cover, the back cover, or somewhere within the catalog.

Montanari et al. disclose a method for tracking the production history of food product. FIG. 1 shows a tag that is encoded with a Tracking Number. According to Montanari, the tag is used to convey 1) an Animal Tracking Number (A-TN) which is the tracking number applied to a live animal; 2) an Offal Tracking Number (O-TN) which is attached to offal products; 3) a Production Tracking Number (P-TN) that is attached to a quarter of meat and that identifies fabricated primals and sub-primals derived from the animal of origin; and 4) a Retail Tracking Number (R-TN) that is presented on a primal or sub-primal cut for retail identification. As ownership and possession of an animal is transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or computer readable form, such as a bar-code or magnetic strip, and vital information, such as prior owners, genetic history, weight, feeding history, microbacterial

profiles, diseases, medications, etc., may be added to the database record via such tag at various times in the growth of the animal, as well as in the fabrication process.

Dudle et al. disclose a custom product estimating and order processing system. According to the system includes the method for generating estimates and orders for the manufacture of custom items such as business forms is provided which stores estimate data at a central location, e.g., a corporate office, for access by sales representatives at remote sales sites. A sales representative creates an item specification for a form to be manufactured and electronically transmits it to the corporate office for estimate data. Data relating to the cost and list price to produce the form based on the item specification is transmitted to the sales representative. The sales representative determines a sell price from the pricing data, and generates a production order using the item specification and the estimate data, among other data. The production order is transmitted to a manufacturing plant for job execution. The system manages a centralized repository of item specification, estimate and customer contract data, among other types of data, for analysis and reporting which can be accessed by computers at different manufacturing plants and sales sites.

References to Brooke, Kaoko and Teruo are cited as evidence showing the use of bar codes for encoding telephone numbers in a telephone directory. See the references for the specific operations of the systems.

### **Remarks**

Due to a large number of claims involving a series of patent applications deriving the benefit from U.S. Patent Application No. 09/365,961 and 08/628,246, the examiner has made an attempt to provide cite all references which are representative of the general teachings of the prior art that are appeared to be pertinent to the underlying concepts of the applicants' invention. In this instant application, since the set of claims is large and is somewhat broad with reference to the teachings of the prior art, the examiner respectfully recommends applicant to review the set of references cited in this Office Action; and to amend the claims accordingly such that they are clearly defined over the prior art of record.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**Le, Thien M.**  
**Primary Examiner**  
**Art Unit 2876**  
**June 25, 2002**